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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,939	01/29/2007	Brian M. Cali	223355-122779	7082
	7590 03/24/201 er Schwartz & Cohn L		EXAM	INER
350 East Michigan Avenue			CHONG, YONG SOO	
Suite 300 Kalamazoo, MI	o, MI 49007-3800		ART UNIT	PAPER NUMBER
,			1627	
			MAIL DATE	DELIVERY MODE
			03/24/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)			
Office Action Summers	10/575,939	CALI ET AL.			
Office Action Summary	Examiner	Art Unit			
	Yong S. Chong	1627			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 16(a). In no event, however, may a reply be tim 11 apply and will expire SIX (6) MONTHS from 12 cause the application to become ABANDONEI	I. lely filed the mailing date of this communication (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on					
· ·	action is non-final.				
3) Since this application is in condition for allowan		secution as to the merits is	i		
closed in accordance with the practice under <i>E</i>					
Disposition of Claims					
4) \(\times\) Claim(s) 1.3.5.6.8.9.17-20.22.23.29.31.37 and	41 islare pending in the applicati	On.			
4a) Of the above claim(s) is/are withdraw		JII.			
5) Claim(s) is/are allowed.	William Consideration.				
6) Claim(s) is/are allowed.					
7) Claim(s) is/are rejected.					
8) Claim(s) 1. 3. 5-6. 8-9. 17-20. 22-23. 29. 31. 37	7 41 are subject to restriction and	Var election requirement			
0)(S) Ciaiii(s) 1, 3, 3-0, 0-9, 17-20, 22-23, 29, 31, 31	<u>, 47</u> are subject to restriction and	i/or election requirement.			
Application Papers					
9)☐ The specification is objected to by the Examine	′.				
10)☐ The drawing(s) filed on is/are: a)☐ acce	epted or b) \square objected to by the E	Examiner.			
Applicant may not request that any objection to the	drawing(s) be held in abeyance. See	37 CFR 1.85(a).			
Replacement drawing sheet(s) including the correcti	on is required if the drawing(s) is obj	ected to. See 37 CFR 1.121(d	l).		
11)☐ The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.			
Priority under 35 U.S.C. § 119					
 12) ☐ Acknowledgment is made of a claim for foreign a) ☐ All b) ☐ Some * c) ☐ None of: 1. ☐ Certified copies of the priority documents 		-(d) or (f).			
2. Certified copies of the priority documents		an No			
	3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).				
* See the attached detailed Office action for a list of		d			
	or and continue copies net receive	.			
Attachment(s)					
1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)			
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	te			
3) Information Disclosure Statement(s) (PTO/SB/08)	5)	atent Application			
Paper No(s)/Mail Date	o) 🔲 Other				

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23, drawn to a pharmaceutical composition comprising the compound of formula I and a pharmaceutically acceptable carrier, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group II, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23, drawn to a pharmaceutical composition comprising the compound of formula I and a pharmaceutically acceptable carrier, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group III, claim(s) 29 is drawn to a method of treating inflammation comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group IV, claim(s) 29 is drawn to a method of treating inflammation comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group V, claim(s) 31 is drawn to a method of treating pain comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group VI, claim(s) 31 is drawn to a method of treating pain comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group VII, claim(s) 37 is drawn to a method of treating anxiety comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group VIII, claim(s) 37 is drawn to a method of treating anxiety comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group IX, claim(s) 41 is drawn to a method of treating a sleep disorder comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group X, claim(s) 41 is drawn to a method of treating a sleep disorder comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-X lack unity because the shared common technical feature is not a contribution over the prior art. Since it is well known in the art, it cannot be considered a special technical feature. In the instant case, the shared common technical feature is a compound of formula I in claim 1.

Unity of invention links the various inventions together by sharing a common special technical feature in each invention. However, when the special technical feature is not a contribution over the prior art, the various inventions may be restricted from each other. In the instant case, unity of invention does not exist because the shared common technical feature is disclosed in Thomsen et al. (1989CA: 153968, 1989, of record); US Patent 6,294,505 B1; US Patent 6,262,098 B1; and WO 00/51685.

Therefore, restriction between the composition and method claims is proper. See MPEP 1850 and 37 CFR 1.475.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Species Election

This application contains claims directed to more than one species of the generic invention.

The species are as follows:

1) a single disclosed compound of formula I in claim 1.

If applicant elects Group I-X, applicant is further required to elect a single disclosed compound of formula I in claim 1 from subsection 1. Currently, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23 are generic to a compound of formula I in claim 1.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the same reasons as stated above

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will then be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR

1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call to the attorney is not required where: 1) the restriction requirement is complex; 2) the application is being prosecuted pro se; or 3) the

examiner knows from past experience that a telephone election will not be made (MPEP § 812.01). Therefore, since this restriction requirement is considered complex, a call to the attorney for telephone election was not made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/YONG S. CHONG/ Primary Examiner, Art Unit 1617